

REMARKS

Claims 1 to 17 and 27 to 32 continue to be under consideration.

Claims 18 to 26 will be withdrawn.

DETAILED ACTION

The Office Action refers to *Response to Amendment*

Examiner acknowledges the reply filed 11/24/2006, due to a file error claims 30-32 were omitted from prior action and are included in the new groupings as specified below. Additionally, the last response from the Applicant's representative was non-compliant, although the restriction was traversed: Applicant must still chose an inventive group. Therefore the following updated restriction is presented below.

The Office Action refers to *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-17 and 27-32, drawn to medical treatment apparatus with an ultrasound generator hand piece with sonotrode and a suction element, classified in class 604, subclass 20.
- II. Claims 18-26, drawn to medical treatment apparatus with an ultrasound generator hand piece with sonotrode and flushing line

and container, classified in class 604, subclass 22.

Applicants respectfully traverse. Applicants believe that the subject matter of claims 18 to 26 is so closely related to the subject matter of claims 1 to 17 and 27 to 32 that these claims should be investigated as to patentability at the same time.

Inventions I and II related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombinations of Group I and II have separate utility such as the device (II) can be used to administer medical treatment along with a medical solution or the device (I) can be used to administer medical treatment and remove excess fluids or gases from the treatment site via the suction means, these activities have separate utility and have separate status in the art. See MPEP § 806.05(d).

Applicants respectfully submit that the subcombinations overlap in the presence of ultrasound. The ultrasound will induce wavelike motions in the medium such that the elements of the

medium are oscillating between a suction direction and a flushing direction.

Additionally, it is submitted that the initiation of a suction pump or of a flushing pump can lead to starting oscillations in the medium, which again result in overlap in the action direction between flushing and suction.

It is further to be considered that there can be a single element producing both flushing and suctioning sequentially depending on a control element and it is respectfully submitted that such single element capable of both suctioning and of flushing would present overlap between the subcombinations. Certainly there exist bi-directional pumps which sequentially suction and flush and which would furnish such overlapping element.

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional

application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Applicants respectfully disagree.

A procedure of restriction requirement followed by a requirement of filing a terminal disclaimer in the divisional application does not appear to be rational.

The Office Action states: “subcombinations of Group I and II have separate utility such as the device (II) can be used to administer medical treatment along with a medical solution or the device (I) can be used to administer medical treatment and remove excess fluids or gases from the treatment site via the suction means,”. Applicants note that device (II) administers a medical solution and that device (I) removes excess fluids. Applicants urge that the administration of liquids and the removal of liquids are closely related and should be examined together.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art

in view of their different classification, restriction for examination purposes as indicated is proper.

Applicants respectfully submit that both subcombinations fall into class 604 into different subclasses 20 and 22. Applicants respectfully submit that both subclasses are directed to a medical treatment apparatus with an ultrasound generator hand piece with sonotrode and a line and it appears that both subclasses 20 and 22 should be searched, since suction line and flushing line distinguish only by an intended use..

Applicants respectfully also submit that the administration of liquids and the removal of liquids are so closely related that they should be examined together.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

Applicants respectfully traverse the restriction requirement. Applicants elect the claims 1 to 17 and 27 through 32 to be examined relative to patentability.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Applicants traverse on the grounds that the inventions are overlapping. Applicants believe further that all subclasses, which refer to a medical treatment apparatus with an ultrasound generator hand piece with sonotrode and line, i. e. subclasses 20 and 22 should be searched in connection with this application.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Applicants are traversing on the ground that the inventions made out in the Office Action are overlapping.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicants thank the Examiner for reminding them that upon cancellation of claims to a non-elected invention under certain circumstances the inventorship must be amended.

Applicants believe at this time that no change in inventorship is appropriate in view of the restriction requirement.

Reconsideration of all outstanding rejections is respectfully requested.

All claims presently submitted are deemed to be in allowable form and a Notice of Allowance is earnestly solicited.

Respectfully submitted,

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